Remarks

In the present response, no claims are amended. Claims 1-23 are presented for examination.

Claim Rejections: 35 USC § 102(e)

Claims 1-23 are rejected under 35 USC § 102(e) as being anticipated by US publication number 2004/0243692 (Arnold). Applicants respectfully traverse this rejection.

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. See MPEP § 2131, also, *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983). Since Arnold neither teaches nor suggests each element in the claims, these claims are allowable over Arnold.

The independent claims recite numerous elements that are not taught in Arnold. Some examples are provided below with respect to specific language appearing in claim 1.

As one example, claim 1 recites "determining a **pattern** for each of the parameterizations based on the system configuration attributes" (emphasis added). The Office Action equates the constraints in paragraph [0044] in Arnold with the claimed "parameterizations." Therefore, the issue is: Does Arnold teach determining a pattern for his constraints? No. Arnold does not.

Arnold does not even mention determining patterns for parameterizations or constraints. Arnold is silent as to determining patterns. The Office Action cites paragraph [0023] in Arnold. This paragraph discusses a management unit that obtains configuration information and usage metrics to execute commands and functions that it deems appropriate. Paragraph [0023] does not mention or even suggest determining patterns for parameterizations or constraints. **Arnold does not even discuss the use of patterns.**

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed (see *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985)).

For at least these reasons, the claims are allowable over Arnold.

As another example, claim 1 recites "comparing substantially each of the managed systems to substantially each of the patterns." Nowhere does Arnold discuss making comparisons of managed systems to patterns for parameterizations based on system configuration attributes. Again, Arnold does not each discuss patterns, let alone making comparisons of patterns with system configuration attributes.

The Office Action cites paragraphs [0045] and [0049]. Paragraph [0049] discusses comparing observed (i.e., monitored) storage attributes with a quality of service. Nowhere, however, does Arnold teach comparing patterns with system configuration attributes. **Arnold does not even discuss the use of patterns.**

For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference (see *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990)).

For at least these reasons, the claims are allowable over Arnold.

As yet another example, claim 1 recites that the "patterns are determined by a supervised machine learning algorithm." The Office Action **admits** that Arnold does not teach a machine learning algorithm. Applicants agree with this admission. The Office Action, however, attempts to cure this deficiency with the principle of inherency. Applicants respectfully disagree.

The Office Action fails to satisfy its burden in rejecting the claims based on inherency. As noted in the MPEP, the Federal Circuit has ruled that:

> To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' MPEP §2112, quoting In re Robertson, 169 F.3d 743, 745 (Fed. Cir. 1999).

Here, no extrinsic evidence has been cited in the Office Action in support of the contention that Arnolds storage system uses machine learning algorithms. Arnold is completely silent on the concept of machine learning algorithms. Arnold does not even contemplate the use of such algorithms. The Office Action has failed to provide a convincing line of reasoning why machine learning algorithms are necessarily present in the storage system of Arnold.

For at least these reasons, the claims are allowable over Arnold.

CONCLUSION

In view of the above, Applicants believe that all pending claims are in condition for allowance. Allowance of these claims is respectfully requested.

Any inquiry regarding this Amendment and Response should be directed to Philip S. Lyren at Telephone No. 832-236-5529. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

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